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IN THE

Supreme Court of the United States

October Term, 1979.

No. 79-1219.

R. W. SIMS, TRUSTEE, and
R. W. SIMS, TRUST,

Petitioners,

v.

MACK TRUCKS, INC.,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Third Circuit.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION.

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT.

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The Respondent, Mack Trucks, Inc. (hereinafter "Mack"), submits this brief in opposition to the Petition for a Writ of Certiorari to the United States Court of Appeal for the Third Circuit filed by Petitioners, R. W. Sims, Trustee and R. W. Sims, Trust (hereinafter collectively referred to as "Sims"), and respectfully prays that the Petition for a Writ of Certiorari be denied.

OPINIONS BELOW.

The opinion of the United States Court of Appeals for the Third Circuit (App. A-1) [1] is reported at 608 F. 2d 87 (1979). The opinion of the United States District Court for the Eastern District of Pennsylvania (App. A-19) is reported at 459 F. Supp. 1198 (1978).

COUNTERSTATEMENT OF THE QUESTIONS PRESENTED.

I. Whether the Court of Appeals erred in defining the level of ordinary skill in the pertinent art.

II. Whether the Court of Appeals held that synergism is required in combination patent cases.

STATUTE INVOLVED.

United States Code, Title 35:

§ 103. Conditions for patentability; non-obvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. The designation "App. A-__" refers to the Petitioners' Appendix.

COUNTERSTATEMENT OF THE CASE.

Sims brought this lawsuit against Mack for infringement of a patent, "the Willard Patent," for a front-discharging self-transit concrete mixer.[2] After trial, the District Court found that the Willard Patent was valid and infringed by Mack. However, the United States Court of Appeals for the Third Circuit reversed the District Court on the ground that the patent was obvious under the criteria established by this Court in *Graham v. John Deere Co.*, 383 U. S. 1 (1966). The Court of Appeals' decision rested solely on its finding that the District Court had defined too restrictively the third criterion of *Graham*—the level of ordinary skill in the pertinent art. In this regard, the Court of Appeals ruled that the hypothetical person with ordinary skill in the pertinent art was one familiar with the design of self-transit concrete mixers and that, to such a person, the Willard Patent was obvious.

The Statement of the Case set forth in the Petition erroneously focuses on the activities of the trustee-Petitioner, R. W. Sims, rather than on the subject matter of the Willard Patent. An examination of the cited evidence, in those infrequent instances where evidence is cited, reveals that the Petition's facts are grossly and irresponsibly misstated.[3] However, since most of these facts are also totally irrelevant, an item-by-item rebuttal is unnecessary. Nevertheless, several facts concerning Mr. Sims are relevant. First, Mr. Sims is not the inventor or patentee; he independently conceived a front discharging transit concrete mixer. When he attempted to patent this construction, his lawyer's patent search revealed that the concrete

2. United States Patent No. 2,859,949 issued on November 11, 1958 to J. Jack Willard. (459 F. Supp. at 1200; App. A-21.)

3. The opinions of the District Court and Court of Appeals set forth a more accurate statement of the relevant facts.

mixer had already been patented by Mr. Willard. Mr. Sims then negotiated an assignment of the Willard Patent rights to the Sims trust. (459 F. Supp. at 1201; App. A-22.) Second, the Petition argues that skepticism as to the workability of the patented device demonstrates the non-obviousness of the Patent (*e.g.*, Petition, pp. 12-13). However, as the District Court found, many improvements had to be made by Mr. Sims and others to the patented construction to make it workable. These improvements, which were not disclosed in the Willard Patent, were responsible for the concrete truck's commercial success. The necessity for these improvements led the District Court to give less weight to the significance of commercial success in considering the Willard Patent's obviousness. (459 F. Supp. at 1206, 1214; App. A-27, A-35.) The fundamental nature of such improvements is exemplified by Mr. Sims' testimony that it took him four years to make the barrel in his front discharging truck mix and discharge properly. (Jt. App. 1681A; see also Jt. App. 1815A, 1821A.)[4] In fact, Mr. Sims gave his opinion at trial as to the workability of the construction disclosed in the Willard Patent:

> In other words, sometimes you can get a drop of water out of the tap, showing that the water system works, but it doesn't always come out as fast as you would like it to, let's put it that way.

(Jt. App. 1896A.) Of course, if you want to take a shower, a drop of water hardly makes the system workable or usable.

Turning to the Willard Patent itself, the most important fact in this case is the finding by the District

4. The designation "Jt. App. —-A" refers to the Joint Appendix filed with the Court of Appeals.

Court that the Willard Patent is a combination patent which consisted solely of a rearrangement of elements present in the prior art. In this regard, the District Court stated:

> 35. The component parts of the Willard vehicle do not differ greatly from components of self-transit mixers which already existed in the prior art. This construction employs a mixing drum already in common use, a chute closely resembling that disclosed in the Merwin patent and a conventional truck chassis and cab. The cylindrical drum extension at the discharging end of the mixing drum in the Willard patent does not conform precisely to anything in the prior art, but it resembles closely the drum extension at the discharging end of the Payne construction both in its general shape (*i.e.*, of reduced diameter relative to the adjacent drum section) and function (*i.e.*, to project the discharge beyond the cab, over it in the Willard construction and under it in the Payne construction). The Willard patent thus represents a rearrangement of elements known in the prior art.

(459 F. Supp. at 1206-7; App. A-27-8.) Like the Willard Patent, the Payne Patent, referenced above, was a "*forward discharging* transit concrete mixer."[5] The primary difference between the Payne Patent and the Willard Patent is that the truck disclosed in the Payne Patent discharged concrete by tilting the mixing drum, whereas the truck disclosed in the Willard Patent discharged concrete by rotating a fixed axis drum. (See drawing and description of the Payne Patent in the District Court opinion, 459 F. Supp. at 1203; App. A-24.) Shockingly, the Payne

5. The quoted language is the title of the Willard Patent. (App. A-45.)

Patent was not cited by the United States Patent Office as prior art in the Willard Patent. (459 F. Supp. at 1203; App. A-24.) The District Court found that the Payne Patent "was among the prior art most pertinent to the Willard patent because it embodies a front-discharge self-transit mixer." Since the Payne Patent was not cited by the Patent Office, the District Court held that the presumption of validity ordinarily accorded a patent was greatly weakened. (459 F. Supp. at 1203, 1210; App. A-24, A-31.)

Given the Payne Patent and the other prior art, the Court of Appeals found:

> In essence, the Willard concept did nothing more than flip the discharge end of the drum from the rear to the front of the truck. That it offered advantages in delivery of the concrete to the construction point, such as reduction of outside help in positioning the chute, is clear. But the gains in maneuverability and elimination of backing the truck, which are characteristics of the front-discharge mode, were also present in the Payne patent.

(608 F. 2d at 91; App. A-9.) Mack's witnesses at trial persuasively indicated that the Willard Patent merely updated the Payne Patent by substituting a modern Oury[6] concrete mixing drum, which existed in the prior art, for the outdated tilt-type drum of the Payne Patent. (Testimony of Stieg: Jt. App. 2323-24A, 2340-41A; Testimony of Essex: Jt. App. 2523-24A.) Even Mr. Fay, Sims' only expert witness on prior art, gave partial, albeit reluctant, support to this proposition. Mr. Fay refused to admit that

6. This patent, described in the District Court opinion (459 F. Supp. at 1201-2; App. A-22-3), is the fixed, inclined axis type mixing drum used in the Willard Patent which discharges the concrete when the drum is rotated in one direction and mixes the concrete when the drum is rotated in the other direction.

it would have been obvious to substitute an inclined fixed axis drum of the Oury type in place of the Payne drum. However, he did concede that "it could be" obvious to substitute a horizontal fixed axis type rotating drum in place of the Payne drum. (Jt. App. 2693A.) When asked whether he knew of anyone who had reversed an Oury-type drum prior to the Willard Patent, he said he did not. Confronted with a prior art patent showing this, he admitted that it was "essentially" an Oury-type drum pointing toward the front. (Id. at 2692-94A.)

REASONS FOR DENYING THE PETITION.

Rule 19(1) of the Rules of the Supreme Court of the United States states that a petition for a writ of certiorari "will be granted only where there are special and important reasons therefor." The Rule sets forth a non-exhaustive list of special and important reasons. None of these are present in this case. Although the instant Petition asserts (Petition, pp. 8-9) that the Circuit Courts have had difficulty in reconciling prior Supreme Court decisions dealing with the obviousness question, it will be seen that no such difficulty was encountered by the Court of Appeals in resolving the instant case. Although the Petition asserts (Petition, pp. 11-12) that the Court of Appeals' decision is inconsistent with *United States v. Adams*, 383 U. S. 39 (1966), it will be seen that the issue decided here by the Court of Appeals was not discussed in *Adams*. Finally, although the Petition points to an apparent conflict in the Circuit Courts as to the requirement of synergism in combination patent cases (Petition, pp. 15-16), the synergism question was not decided by the Court of Appeals in this case. In short, the Court of Appeals' decision in this case rests upon the proper application to this particular patent of the test set forth by this Court in *Graham v. John Deere Co.*, 383 U. S. 1 (1966). The value of the Court of Appeals' decision in this case as a precedent for other cases is accordingly so limited. This case was correctly decided, and, more importantly, it is not worthy of review by the United States Supreme Court.

I. The Court of Appeals Did Not Err in Defining the Level of Ordinary Skill in the Pertinent Art.

The Petition, at page 7, recites the three step analysis set forth by this Court for obviousness cases in *Graham v. John Deere Co.*, 383 U. S. 1 (1966) and then asserts:

"This appeal involves the third factual inquiry, namely, the resolution of the level of ordinary skill in the pertinent art." (*Id.*) Mack agrees that this is the issue in this case. Mack objects, however, to Sims' attempts to "puff up" this issue into something that it is not. For example, in the questions presented, Sims asserts that the Court of Appeals applied a nonobjective standard of patent validity. This misses the mark. The Court of Appeals did not apply any new standards. It simply held that the District Court erred in its application of the third test of *Graham* relating to the ordinary skill in the pertinent art. The Court of Appeals' decision rests on the Court's conclusion that, since the Willard Patent was a combination patent, each of the elements of which was present in the prior art and performed the same functions in the Willard Patent as they performed in the prior art, the District Court set too high a standard for the hypothetical person with "ordinary skill in the pertinent art."

It was on the District Court's definition of the level of ordinary skill in the pertinent art that the Court of Appeals specifically reversed. The District Court held that the hypothetical person with ordinary skill in the pertinent art was the designer of self-transit concrete mixing trucks. (459 F. Supp. at 1211; App. A-32.) In setting this standard, the District Court attempted to follow the admonition in *Systematic Tool & Machine Co. v. Walter Kidde & Co.*, 555 F. 2d 342, 349 (3d Cir.), *cert. denied*, 434 U. S. 857 (1977), that such a hypothetical person is "the mechanically skilled individual familiar with the design of devices in the industry."[7] The Court of Appeals

7. The Petition's assertion (Petition, pp. 9-10) that *Systematic Tool* is not consistent with *Universal Athletic Sales Co. v. American Gym, Recreational & Athletic Equip. Corp.*, 546 F. 2d 530 (3d Cir. 1976), *cert. denied*, 430 U. S. 984 (1977) is incorrect and is not

found the District Court's analysis erroneous in that it misconstrued the word "design" and assumed that only a person knowledgeable in the construction of a concrete mixing truck from the ground up could evaluate the obviousness of the Willard Patent. As a result of its mistaken definition of the level of ordinary skill in the pertinent art, the District Court discounted the testimony of Richard Essex, one of Mack's experts, on the ground that he was not a designer of transit concrete mixer trucks. (459 F. Supp. at 1212; App. A-33.)

As established at trial, Essex's qualifications as an expert were considerable. He was a graduate civil engineer who had used transit concrete mixers and had been in the ready-mix concrete business since 1933. During this time, he was responsible for a fleet of 28 trucks. As such, Mr. Essex purchased truck chassis and mixer drums separately from different companies. He properly matched the chassis and mixer drums and made other engineering decisions relevant to selecting such components. Also, he supervised the mechanics who put the mixers and chassis together. (Jt. App. 2459-74A.) From his intimate involvement in the concrete business, he had knowledge of the prior art and the advantages of the different types of mixers. (Jt. App. 2479-89A.)

7. (Cont'd.)
what the Court of Appeals said in its opinion in this case. Rather, the Court of Appeals merely observed that determining the person with ordinary skill in the pertinent art is difficult, as demonstrated by the two referenced decisions. What these two decisions demonstrate is that the question of who has ordinary skill in the pertinent art must be decided on the basis of the nature of the particular patent at issue. In both cases, the Court of Appeals evaluated the degree of difficulty of the subject matter of the patent in determining the standard by which to judge obviousness. In this case, the Court of Appeals held that the degree of difficulty in a combination patent, where all elements exist in the prior art and function as they did in the prior art, is not high, and that the standard must be set with this in mind.

The Court of Appeals correctly recognized that assembling major components of the concrete mixer in a different way was the essence of the Willard Patent. Additionally, the Court of Appeals recognized that the Willard Patent did not involve detailed mixer design such as the design of a transmission or the design of drum internals. In fact, Mr. Fay, Sims' witness, admitted this:

> Q. Now, is it your testimony that by looking at Willard one can construct a front-discharge mixer?
>
> A. No. I think there are some other aspects.
>
> Q. It takes a good bit of work to design a working vehicle, doesn't it?
>
> A. Yes.
>
> Q. In fact, isn't that one reason that you went out to Salt Lake City in 1964 to see how Mr. Sims did it?
>
> A. Indeed.
>
> Q. Indeed, aren't you also aware that it took Mr. Sims a long time to come up with a working vehicle even though Willard was available?
>
> A. Yes.

(Jt. App. 2695A.) The fact is that the Willard Patent teaches not the design or construction of a truck but merely the arrangement of the major component parts.[8] The District Court's restriction of hypothetical persons with ordinary skill in the pertinent art to truck designers therefore was manifestly erroneous.

In discussing the level of ordinary skill in the pertinent art, the Petition fails to point to any legitimate reason why this Court should review this case. Although the Petition

8. Mr. Essex testified that there was nothing in the Willard Patent or the Payne Patent which he could not understand because of its technical nature. (Jt. App. 2490A, 2511A.)

contends, at pages 8-9, that there is confusion among the Circuit Courts, it fails to state clearly what the confusion is, or whether the alleged confusion involves the issue presented in *Graham* of the level of ordinary skill in the pertinent art. Except for the Third Circuit cases discussed above in footnote 7, Petitioner cites (Petition, p. 9) only two cases, *Republic Industries, Inc. v. Schlage Lock Co.*, 592 F. 2d 963 (7th Cir. 1979) and *Herschensohn v. Hoffman*, 593 F. 2d 893 (9th Cir.), *cert. denied*, 100 S. Ct. 84 (1979), for the proposition that there is confusion among the Circuit Courts. However, neither of these cases even deals with the issue raised here—the level of ordinary skill in the pertinent art. Rather, both cases relate to the requirement of synergism which, as will be seen below, was not addressed by the Court of Appeals' opinion. In *Republic Industries*, the Seventh Circuit noted that synergism is not required in a combination patent and that the three-pronged test of *Graham* should be applied to determine patent validity under 35 U. S. C. § 103. 592 F. 2d at 969. Application of the *Graham* test in that case resulted in *invalidating* the patent for obviousness. Likewise, in *Herschensohn*, the Ninth Circuit addressed the issue of synergism, not the level of skill in the pertinent art. The Court there held that synergism was required in a combination patent and that the patent at issue was obvious because it did not produce any new, unusual, or synergistic result. 593 F. 2d at 897.

The Petition spends two pages (Petition, pp. 11-12) discussing *United States v. Adams*, 383 U. S. 39 (1966). However, as in the other cases cited by Sims, *Republic Industries* and *Herschensohn*, the issue of the level of ordinary skill in the pertinent art was not discussed. Nor was *Adams* a combination patent case in which all of the prior art elements performed the same function as in the

prior art. In *Adams*, the fact that the prior art elements functioned differently, or as in this Court's assessment, the fact that they had "an interdependent functional relationship," made the patent valid and the invention non-obvious. 383 U. S. at 50. Accordingly, Sims' discussion of *Adams* is inapposite to the present case.

II. The Court of Appeals Did Not Hold That Synergism Is Required in Combination Patent Cases.

The second question presented by the Petition is stated as whether "synergism" is a new, independent and cumulative requirement for the patentability of combination mechanical inventions under 35 U. S. C. § 103. (Petition, p. 2.) The Petition then refers to what it claims to be a division among the Circuit Courts on this question. (Petition, p. 15.) However, the Petition fails to recognize that the Court of Appeals did not even reach the synergism issue in this case:

> In view of our holding that the patent at issue fails to meet the test for obviousness set down by Graham, we need not rule on the question whether a finding of synergism is a precondition to validity in all such cases.

(608 F. 2d at 93; App. A-12.) (Footnote omitted.) Thus, the synergism issue is totally irrelevant to the issues raised by the Court of Appeals' decision.

CONCLUSION.

Because the decision of the United States Court of Appeals for the Third Circuit was correct and because no special or important issues warrant this Court's review, Respondent Mack Trucks, Inc. respectfully requests that the Petition for a Writ of Certiorari be denied.

Respectfully submitted,

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